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OFFICE OF PETITIONS

In re Application of
Nelms, et al.
Application No. 10/085,454
Filed: February 27, 2002
Attorney Docket No. DSC-7A
For: NON-RECTANGULAR SHAPED CREDIT
CARD WITH CASE

: DECISION ON PETITION
: UNDER 37 CFR §1.78(a)(3)

This is a decision on the reconsideration petition under 37 CFR §1.78(a)(3), filed May 23, 2005 (certificate of mailing date May 20, 2005), to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed nonprovisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §1.78(a)(2)(ii). In addition, the petition under 37 CFR §1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. §120 and 37 CFR §1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in §1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

While the instant petition complies with the above-listed requirements for a grantable petition under 37 CFR 1.78(a)(3), a closer review of the two applications in question, application No. 10/085,454 and application No. 29/133,861, reveals that **the two applications do not have an**

inventor in common. The inventors for application no. 10/085,454 are: Nelms, Schick, and Wilson. The inventor for application no. 29/133,861 is Hochschild.

As stated in MPEP 201.11 Continuity Between Applications: the Benefit of an Earlier Filing Date, Section IV. SAME INVENTOR OR INVENTORS, " The statute also requires that the applications claiming benefit of the earlier filing date under 35 U.S.C. §119(e) or §120 be filed by an inventor or inventors named in the previously filed application or provisional application."

Because application no. 10/085,454 and application no. 29/133,861 do not have an inventor in common, the petition cannot be granted. The Office regrets not uncovering this fatal flaw in the previous petitions. Nevertheless, the statute cannot be waived.

Petitioner should submit a replacement paragraph [0001] reiterating the claim for benefit under 37 CFR §119(e) of U.S. Provisional Application Serial No. 60/306,743, filed July 20, 2001, which was incorporated by reference.

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Petitions Attorney E. Shirene Willis at (571) 272-3230.

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